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10/810,387

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EXAMINER

LANG, AMY T

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/810,387 | Applicant(s) SINGH ET AL. | |
| | Examiner AMY T. LANG | Art Unit 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/06/2009 has been entered.

Specification

2. The amendment filed 05/27/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- i. the amendments to page 9 including I, II, III, and IV for preparing the cutting oil.
- ii. the amendments to page 10 which include the diluting the oil in water in a ratio of 60 to 90 wt%.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections – 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1-33** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant claim 1 recites the following where each is not supported by the instant specification:

- i. stirring the fluid with 60 to 98 wt% water to convert the fluid into emulsion
- ii. wherein the emulsion is useful as a soluble cutting oil
- iii. wherein the emulsion is useful as a coolant
- iv. wherein the emulsion has less toxicity than mineral oil (Although paragraph [0008] of the instant specification teaches the toxicity will be reduced, it does not specifically state that the toxicity will be reduced compared to mineral oil. Additionally, this paragraph does not state that the emulsion has less toxicity as recited in the instant claim).

Claims 1 states wherein the heavy alkyl benzene is from a waste heavy fraction which is also not supported by the instant specification.

Claim 1 states wherein the emulsifier is a heavy alkyl benzene sulfonate. Although the instant specification lists several emulsifiers, this compound is not included in that list (see paragraph [0023]).

Claim 1 states wherein the lubricity booster is mahua oil. Although the instant specification lists several lubricity boosters, this compound is not included in that list (see paragraph [0021]).

Claim 1 states wherein the antioxidant is a 2,6-ditertiary butyl-4-methyl phenol. Although the instant specification lists several antioxidants, this compound is not included in that list (see paragraph [0025]).

Claim 1 states wherein the fungicide is a benzyl thri-ethyl ammonium chloride or a tetradecyl pyridinium bromide. Although the instant specification lists several fungicides, these compounds are not included in that list (see paragraph [0027]).

Claim 1 states wherein the extreme pressure additive is a zinc dialkyl dithio phosphate. Although the instant specification lists several emulsifiers, this compound is not included in that list (see paragraph [0029]).

Claims 2-33 are dependent on claim 1 and therefore are also not supported by the instant specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. **Claims 1-33** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites wherein the heavy alkyl benzene is “a waste heavy fraction from detergent class linear alkyl benzene manufacturing.” However, it is not clear as to what is meant by waste heavy fraction. Is the alkyl benzene produced from a waste stream of linear alkyl benzenes?

Claim 1 recites wherein the emulsion adds value to a waste product. However, this term is vague and unclear. Specifically, what kind of value is added or how much value? Since the claim fails to identify the added value, the claim is rendered indefinite.

Claim 3, which is dependent on claim 1, teaches the emulsifier as an alkyate sodium sulfonate. However, claim 1 lists several emulsifiers but does not include this compound. Since dependent claim 3 further limits independent claim 1, it is therefore unclear if claim 1 is intended to also include this compound as one of the emulsifiers.

Claim 4, which is dependent on claim 1, teaches the lubricity booster as castor oil. However, claim 1 lists several lubricity boosters but does not include this compound. Since dependent claim 4 further limits independent claim 1, it is therefore unclear if claim 1 is intended to also include this compound as one of the lubricity boosters.

Claims 2-33 are dependent on claim 1 and therefore are also indefinite.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 1-12 and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Anantaneni (US 6,630,430) in view of Boffa (US 5,804,537), Tanaka (US 6,245,725 B1), Camenzind (US 7,026,438 B2), Van Dam (US 6,784,142 B2), Matsushita (US 5,741,763), Zoch (US 3,902,868), and Otaki (US 4,765,917).

Anantaneni discloses a lubricating composition for a metal surface, specifically an internal combustion engine (column 1, lines 14-19; claim 39, column 38). The composition is comprised of alkyl benzenes, having 18 to 30 carbon atoms, to enhance detergency (column 1, lines 20-25, 55-58). The alkyl benzenes are present in the lubricating composition from 35 to 82 wt% of the total composition (claim 1, column 32). Anantaneni teaches the method to produce the alkyl benzenes useful in the lubricant composition, which results in a fraction by-product separated from detergent class alkyl

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benzene (column 3, lines 19-43). Furthermore, Anantaneni discloses the use of additives in the composition including extreme pressure additives, antioxidants, and more (column 21, lines 38-45).

Anantaneni does not specifically disclose the addition of (i) an emulsifier, (ii) a lubricity booster, (iii) an antioxidant, (iv) an antirust agent, (v) a coupling agent, (vi) a fungicide, (vii) an extreme pressure additive, (viii) a co-surfactant, (ix) an alkali component, or (x) that the composition would be converted into an emulsion when stirred with 60 to 90 wt% water so that the resulting emulsion is useful as a cutting oil and a coolant, has less toxicity than mineral oil, and adds value to a waste product.

With respect to (i) above, Boffa discloses a lubricating composition for an internal combustion engine comprised of alkylated sodium sulfonates from 5 to 80 wt% (column 1, lines 6-10; column 4, lines 15-21; column 5, lines 18-21). This additive aids in producing superior engine deposit performance (column 3, lines 16-21). Although Boffa does not specifically disclose the alkylated sodium sulfonates additive as an emulsifier, given that the property of a compound is inseparable from the compound, it therefore would intrinsically function as one in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a lubricating composition for an internal combustion engine and Boffa discloses that sodium sulfonate additives are advantageous in engine deposit performance, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (ii) above, Tanaka discloses that additives are added to engine lubricating oils in order to reduce frictional losses (column 1, lines 30-34). One such

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additive is castor oil in an amount of 0.05 to 10 wt% (column 18, lines 28-30, 38; column 19, lines 16-19). Although Tanaka does not specifically disclose the castor oil additive as a lubricity booster, given that the property of a compound is inseparable from the compound, it would intrinsically function as one in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a lubricating composition for an internal combustion engine and Tanaka discloses that additives including castor oil reduce frictional losses in an engine, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (iii), (iv), and (v) above, Camenzind discloses a lubricating composition, specifically metal working fluid, comprised of additives to further improve performance properties (column 7, lines 60-66). The additives include the antioxidant diphenylamine, calcium petroleum sulphonates, and petroleum sulfonates each in an amount from 0.01 to 10.0 wt% (column 8, lines 2-5; column 10, line 10; column 11, lines 29 and 60). Although Camenzind does not specifically disclose the calcium petroleum sulphonates as antirust agents or the petroleum sulfonates as coupling agents, given that the property of a compound is inseparable from the compound, they would intrinsically function as such in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a metal working fluid and Camenzind teaches the advantage of using these additives, it would have been obvious for Anantaneni to also utilize these additives.

With respect to (vi) above, Van Dam discloses a lubricating composition for an internal combustion engine comprised of specific additives (column 2, lines 48-59). The

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additives include a hindered phenol, which overlaps the instantly claimed phenol, from 0 to about 2.0 wt% (column 5, lines 28-31). The phenol additive aids in lowering water deposits in engines, improving dispersion of soot in engines, and controlling wear and valve train wear (column 2, lines 52-59). Although Van Dam does not specifically disclose the phenol additive as a fungicide, given that the property of a compound is inseparable from the compound, it would intrinsically function as such in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a lubricating composition for an internal combustion engine and Van dam teaches the advantage of a phenol additive in an internal combustion engine, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (vii) above, Matsushita discloses a metal working lubricant comprised of additives conventionally used in lubricant oils (column 1, lines 13-23; column 4, lines 16-22). One of these conventional additives is specifically disclosed as diphenyl disulfide in an amount from 0.01 to 5 wt% (column 4, lines 30, 51-53). Although Matsushita does not specifically disclose the additive as an extreme pressure agent, given that the property of a compound is inseparable from the compound, it would intrinsically function as such in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a metal working fluid comprised of an extreme pressure agent and Matsushita discloses that diphenyl disulfide is a conventional additive in the lubricant art, it would have been obvious for Anantaneni to also utilize this additive.

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With respect to (viii) above, Zoch discloses a fuel composition utilized in internal combustion engines (column 1, lines 6-7). The composition is comprised of specific additives that provide increased combustion efficiency, reduced gaseous pollutant emissions, and reduced volatility of the fuel additive (column 1, lines 44-49). One such additive is disclosed as isopropanol from 10 to 20 wt% (column 2, lines 16-25). Since Anantaneni discloses a lubricating composition for an internal combustion engine that can be utilized in fuels (column 31, lines 57-65), and Zoch discloses the advantage of an isopropanol additive to a fuel composition, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (ix) above, Otaki discloses a lubricant composition for use in high temperature applications (column 1, line 66 through column 2, line 3). One extreme pressure additive is specifically disclosed as calcium carbonate, which clearly overlaps the instantly claimed alkali metal component, in an amount from 1 to about 16 wt% (column 2, lines 25-29; column 3, lines 56-60). This additive is selected since it can function under extremely high pressure conditions (column 3, lines 60-62). Therefore, since Anantaneni discloses a lubricating composition comprised of extreme pressure agents for an internal combustion engine, a high temperature environment, and Otaki discloses a specific extreme pressure agent for a high temperature environment, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (x) above, given that the combination of the above cited references leads to the claimed composition as explained above, therefore the composition would intrinsically also form an emulsion when stirred with 60 to 90 wt%

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water so that the resulting emulsion is useful as a cutting oil and a coolant, has less toxicity than mineral oil, and adds value to a waste product.

Response to Arguments

10. Applicant's arguments filed 05/27/2009 have been fully considered but they are not persuasive.

Specifically, applicant argues (A) that the toxicity of HAB is less than petroleum oil so that the toxicity of an emulsion of HAB in water will also be less than the toxicity of an emulsion of petroleum oil in water.

With respect to argument (A), the instant claims recite wherein the emulsion has less toxicity than mineral oil. Therefore, the claims do not teach an emulsion of petroleum oil in water, as argued, but instead compare the toxicity to mineral oil. Although the toxicity of HAB may be well known in the art, the instantly claimed emulsion also comprises all the claimed additives.

Specifically, applicant argues (B) that Anantaneni is directed to the synthesis of alkyl benzene whereas the instant invention is directed to a metalworking fluid.

With respect to argument (B), the abstract of Anantaneni specifically discloses a lubricating composition, and not just a process of making alkyl benzene. Although Applicant further argues that a lubricating composition is quite different from a metalworking fluid, such is not found persuasive. The lubricant of Anantaneni is able to function as a metalworking fluid and therefore meets this claim limitation. Claim 1 does

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not recite a method of using the concentrate but merely is directed to an apparatus claim. The examiner's position is supported by case law, which holds that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) and MPEP 2111.02.

Specifically, applicant argues (C) that Anantaneni does not disclose the same heavy alkyl benzene as claimed.

With respect to argument (C), the instant specification does not support the instantly claimed alkyl benzene so the argument is not considered persuasive.

Specifically, applicant argues (D) that the inventions and compositions of Boffa, Tanaka, Carmenzind, Van Dam, Matsushita, Zoch, and Otaki are different from the instant invention.

With respect to argument (D), each of the above references teaches that specific components are well known in the art and obvious to use with the Anantaneni composition. Therefore, the fact that the above references teach different final compositions is not persuasive since they are only used to teach a specific component.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMY T. LANG whose telephone number is (571)272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

01/20/2009
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